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PATENT
Attorney Docket No. 019281-001610US

TOWNSEND and TOWNSEND and CREW LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John J. Sie, et al.

Application No.: 09/877,317

Filed: June 8, 2001

For: PRE-STORING MULTIPLE
PROGRAMS WITH USER CONTROL
OF PLAYBACK

Confirmation No. 9420

Examiner: Alina A. Boutah

Technology Center/Art Unit: 2443

APPELLANTS' BRIEF UNDER
37 CFR §41.37

Via EFS-Web

Mail Stop Appeal Brief

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed on October 10, 2008 and the Notice of Panel Decision from Pre-Appeal Brief Review mailed December 17, 2008 for the above-referenced application, Appellants submit this Brief on Appeal.

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1. REAL PARTY IN INTEREST

The real party in interest in this appeal is Starz Entertainment Group LLC of Englewood, Colorado, as the Assignee of the above-identified application.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. STATUS OF CLAIMS

Claims 1-8 and 16-18 have been canceled. Claims 9-15 and 19-32 are pending and stand rejected by the final Office Action dated July 10, 2008. More specifically, claims 9-15 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 9-15 and 19-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,280 to Inoue et al. ("Inoue"). These rejections are believed to be improper and are the subject of this appeal. A copy of the claims as rejected is attached as **9. Claims Appendix**.

4. STATUS OF AMENDMENTS

The claims have been amended five times in this patent application. More specifically, the following is a chronology of the Appellants' amendments denoting the claims amended in each:

1. An Amendment was filed March 7, 2005 in response to the first Office Action mailed December 2, 2004. In this Amendment, claim 19 was amended.

2. An Amendment was filed April 12, 2006 in response to a non-final Office Action mailed January 9, 2006. In this Amendment, claims 16-18 were canceled.

3. An Amendment was filed May 24, 2007 in response to an Election/Restriction Office Action mailed December 18, 2006. In this Amendment, claims 1-8 were withdrawn, and claims 9-15 and 19-21 were elected.

4. An Amendment Under RCE was filed October 10, 2007 in response to the final Office Action mailed August 13, 2007. In this Amendment, claim 19 was amended, claims 22-27 were added and previously withdrawn claims 1-9 were canceled.

5. An Amendment was filed March 26, 2008 in response to the non-final Office Action mailed December 26, 2007. In this Amendment, claims 9, 11, and 19 were amended, and claims 28-32 were added.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The invention “relates in general to content delivery and, more specifically, to delivering a program to an individual business or residence.” Application, page 1, lines 10-11. The embodiment of claim 9 relates to a method for receiving a program by a user location that is sent from a remote provider. Id. at page 4, line 23, page 5, line 8 – page 7, line 10, and page 23, line 8 – page 24, line 2. This method includes determining if any of a first segment of each of a plurality of programs sent from the content provider are not already stored. Id. at page 31, lines 28-31 and page 34, lines 3-6. Any first segment of each of the plurality of programs that are not already stored is recorded. Id. at page 31, lines 28-31 and page 34, lines 3-6. Determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs. Id. at page 4, lines 27 and 28, page 19, lines 32-33 and page 20, lines 15-17. The user request for one of the plurality of programs is detected and a second segment of the one of the

plurality of programs is recorded in response to the detecting step. Id. at page 4, lines 28-30, page 20, lines 3-7, page 32, lines 3-9, page 33, lines 23-25, and page 34, lines 7-10.

The embodiment of claim 19 relates to a method for receiving a program by a user location that is sent from a content provider. Id. at page 4, line 23, page 5, line 8 – page 7, line 10, and page 23, line 8 – page 24, line 2. This method includes recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program. Id. at page 4, lines 27-30, page 19, lines 32-33, page 20, lines 15-17, page 31, lines 28-31 and page 34, lines 3-6. The user request for a selected program of the plurality of programs is detected and a second segment of the selected program is recorded if the user request is detected before a stagger period expires. Id. at page 4, lines 28-30, page 20, lines 3-7, page 32, lines 3-9, page 33, lines 23-25, and page 34, lines 7-10. The stagger period is less than a duration of the program. Id. at page 20, lines 8-13, page 29, lines 20-26, page 30, lines 1-4

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 9-15 under 35 U.S.C. § 112, first paragraph, fail to comply with the enablement requirement.

2. Whether claims 9-15 and 19-32 under 35 U.S.C. § 103(a) are unpatentable over Inoue.

7. ARGUMENT

1. Whether claims 9-15 under 35 U.S.C. § 112, first paragraph, fail to comply with the enablement requirement.

The final Office Action has rejected claims 9-15 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. More specifically, the final Office Action alleges that “the specification does not disclose ‘wherein determining if

any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs' as amended." The Applicants respectfully submit that support for these recitations can be found throughout the specification including but not limited to Fig. 21 and 22 and the accompanying description on pages 32-34 of the description. For example, the first paragraph of page 34 describes recording the first portion of any new program, i.e., any program within the multiplex "that do not currently have a first portion stored." It is also noted that this recording is described as occurring before the user requests the program, i.e., automatically, such that the program can be presented "on demand" and without the delay of waiting for the next cycle. See also page 10, line 22 – page 11, line 18 describing a set-top box receiving and storing programs, page 19, line 17 – page 21, line 26 describing the multiplex and storing programs broadcast therein, and page 20, lines 15-17 noting that such storage can be done before the program is requested. The applicants respectfully contend that such a description is clearly sufficient to enable one of ordinary skill in the art to practice the invention. Therefore, the Applicants respectfully request withdrawal of the rejection.

2. *Whether claims 9-15 and 19-32 under 35 U.S.C. § 103(a) are unpatentable over Inoue.*

In order to establish a *prima facie* case of obviousness, all claimed limitations must first be taught or suggested by the prior art. See, e.g., *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). The Office Action must then provide an explicit analysis supporting the rejection. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"). While the Office Action can use one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Office Action to demonstrate that all the claim elements are shown in the prior art. See MPEP §2143. As will be discussed below, the reference cited by the Office Action does not teach or suggest each

claimed limitation. For example, Inoue does not teach or suggest recording all first segments of a plurality of programs sent from a content provider before a user request for a program. Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims.

Inoue “relates to a video signal receiver for a near video-on-demand broadcast system.” (Column 1, lines 7-8) In one embodiment of Inoue, “the near video-on-demand signal receiver pre-stores the first segment of a desired video program in the buffer memory apparatus.” (Column 8, lines 35-38) “When a user requests reception and display of the video program, the pre-recorded segment is immediately reproduced and displayed while the receiver scans the channels carrying the program for the remaining segment of the program.” (Column 8, lines 38-42) “Once a transmission of the remaining segment is found, the corresponding video signals are received, stored, reproduced, and displayed.” (Column 8, lines 42-44)

That is, Inoue teaches storing a portion of a requested program that can be played out while remaining portions of the program are located and received. As noted in Inoue, “by storing a portion of a selected video program, the receiver can display the stored portion of the program while awaiting or receiving transmission from the broadcaster of a subsequent portion of the program.” (Col.3, lines 60-63) However, Inoue does not teach or suggest storing a first segment of each of a plurality of programs. In other words, Inoue does not teach or suggest storing the first segment of all of a plurality of programs. Rather, Inoue teaches storing a program that is selected in some way such as identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (See e.g., Col. 8, lines 49-57) Thus, only selected programs are stored, not a first segment of all programs.

In response to these arguments, the final Office Action notes that “Inoue teaches recording a first segment of a plurality of programs sent from the content provider, but not necessarily all of the programs” and argues that “one of ordinary skill in the art would recognize

that this is an obvious variation of the teaching of Inoue.” However, the Applicants respectfully reiterate that Inoue does not teach or suggest recording all or any first portion before a program is selected or requested by the user as discussed in detail above. Rather, Inoue teaches storing a program that is selected in some way such as identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. For at least these reasons the Applicants respectfully contend that the rejection is improper and should be withdrawn.

Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any given channel. For example, see figures 2A through 4B and the accompanying description of Inoue in which is described a program being played out in its entirety on any given channel. Upon selection of one of the programs, a first portion, e.g., a first seventeen minutes, or the program is recorded. However, this first seventeen minutes is not sent from the content provider as a first segment. Rather, it is sent as apart of the broadcast of the entirety of the program. So, for example, Inoue cannot implement a method “wherein the first digital channel does not send the second segment” as recited in new claim 28 or wherein the first segment is sent only once as recited in new claim 29. Also, Inoue cannot implement a method “wherein the first segment is sent via a first delivery mechanism and the second segment is sent via a second delivery mechanism” as recited in new claim 31 or “wherein the first delivery mechanism comprises a cable television network and the second delivery mechanism comprises a broadband network connection” as recited in new claims 32.

Claim 9, upon which claims 10-15, 22-24, and 28-32 depend, recites in part “determining if any of a first segment of each of a plurality of programs sent from the content provider are not already stored; [and] recording any first segment of each of the plurality of programs that are not already stored, wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are

performed before any user request for any of the plurality of programs.” However, Inoue does not teach or suggest determining if any of a first segment of each of a plurality of programs sent from the content provider and recording any first segment of each of the plurality of programs that are not already stored before any user request for any of the plurality of programs are not already stored, i.e., recording all first segments. Rather, Inoue teaches pre-recording only portions of a selected programs based on identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (Column 8, lines 47-57.) Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any given channel. For at least these reasons, the rejection should be withdrawn and claims 9-15, 22-24, and 28-32 should be allowed.

Claim 19, upon which claims 20, 21, and 25-27 depend, recites in part “recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program.” However, Inoue does not teach or suggest recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program. Rather, pre-recording only portions of a selected programs based on identifying a predetermined time the segment will be broadcasted, uploading the segment from a memory device, programming the device to record the program, etc. (Column 8, lines 47-57.) Furthermore, Inoue does not teach or suggest program segments as recited in the pending claims or receiving or storing program segments as recited in the pending claims. Rather, Inoue disclose only sending an entire program on any given channel.

For at least these reasons, the final rejection of claims 19-21 and 25-32 is believed to be improper. Therefore, the Appellants respectfully request reversal of the rejection and allowance of the claims.

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,

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9. CLAIMS APPENDIX

1.-8. (Canceled)

9. (Previously Presented) A method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

determining if any of a first segment of each of a plurality of programs sent from the content provider are not already stored;

recording any first segment of each of the plurality of programs that are not already stored, wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs;

detecting the user request for one of the plurality of programs; and

recording a second segment of the one of the plurality of programs in response to the detecting step.

10. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs.

11. (Previously Presented) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment is sent on a first digital channel and the second segment is sent on a second digital channel.

12. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders.

13. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs.

14. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of:
receiving a wireless request from a remote control; and
processing the wireless request to determine a desired program.

15. (Original) The method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location.

16-18. (Canceled)

19. (Previously Presented) A method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:
recording a first segment of all of a plurality of programs sent from the content provider before any user request for the program;
detecting the user request for a selected program of the plurality of programs; and
recording a second segment of the selected program if the user request is detected before a stagger period expires, wherein the stagger period is less than a duration of the program.

20. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment.

21. (Original) The method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location.

22. (Previously Presented) The method of claim 9, wherein the first segment of each of the plurality of programs is sent from the content provider once.

23. (Previously Presented) The method of claim 22, wherein the first segment of each of the plurality of programs are sent from the content provider on the same channel.

24. (Previously Presented) The method of claim 23, wherein the second segment of the one of the plurality of programs is sent from the content provider more than once and on more than one channel.

25. (Previously Presented) The method of claim 19, wherein the first segment of each of the plurality of programs is sent from the content provider once.

26. (Previously Presented) The method of claim 25, wherein the first segment of each of the plurality of programs are sent from the content provider on the same channel.

27. (Previously Presented) The method of claim 26, wherein the second segment of the selected program is sent from the content provider more than once and on more than one channel.

28. (Previously Presented) The method of claim 11, wherein the second digital channel does not send the first segment.

29. (Previously Presented) The method of claim 28, wherein the first digital channel does not send the second segment.

30. (Previously Presented) The method of claim 9, wherein the first segment is sent only once.

31. (Previously Presented) The method of claim 9, wherein the first segment is sent via a first delivery mechanism and the second segment is sent via a second delivery mechanism.

32. (Previously Presented) The method of claim 31, wherein the first delivery mechanism comprises a cable television network and the second delivery mechanism comprises a broadband network connection.

10. EVIDENCE APPENDIX

None.

11. RELATED PROCEEDINGS APPENDIX

None.